

REMARKS

In the final Office Action¹, the Examiner:

rejected claims 1-4, 6-12, and 14-20 under 35 U.S.C. § 112, second paragraph;

rejected claims 1, 4, 9, 12, and 17 under 35 U.S.C. § 103(a) as being unpatentable over a translation of JP 2000-187631 to Sakamaki ("Sakamaki") in view of U.S. Patent Application Publication No. 2002/0059244 to Bunney et al. ("Bunney");

rejected claims 2, 3, 10, 11, and 18 under 35 U.S.C. § 103(a) as being unpatentable over *Sakamaki* in view of U.S. Patent No. 6,519,571 to Guheen et al. ("Guheen");

rejected claims 6, 8, 14, 16, and 19 under 35 U.S.C. § 103(a) as being unpatentable over *Sakamaki* in view of U.S. Patent No. 6,493,673 to Smith et al. ("Smith") and further in view of *Bunney*; and

rejected claims 7, 15, and 20 under 35 U.S.C. § 103(a) as being unpatentable over *Sakamaki* in view of U.S. Patent No. 6,571,234 to Knight et al. ("Knight") in view of *Bunney*.

Applicants have amended claims 1, 2, 6, 7, 9, 10, 14, 15, and 17-20.

Claims 1-4, 6-12, and 14-20 are pending.

In light of the following remarks, Applicants respectfully request the Examiner's timely reconsideration and allowance of currently pending claims 1-4, 6-12, and 14-20.

I. The Rejection of Claims 1-4, 6-12, and 14-20 under 35 U.S.C. § 112, second paragraph

The Examiner indicates that independent claims 1, 2, 6, 7, 9, 10, 14, 15, and 17-20 contain the term "a second virtual community" twice (Office Action at p. 3).

Applicants have amended the independent claims for clarification. Dependent claims 3,

¹ The final Office Action contains statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the final Office Action.

4, 8, 11, 12, and 16 were apparently rejected solely due to their dependence from rejected independent claims. Therefore, Applicants respectfully request the Examiner to withdraw the rejection of claims 1-4, 6-12, and 14-20 under 35 U.S.C. § 112, second paragraph.

II. The Rejection of Claims 1, 4, 9, 12, and 17 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1, 4, 9, 12, and 17 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established. The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) .

... The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III). In this application, a *prima facie* case of obviousness has not been established because the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Examiner has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Independent claim 1, for example, recites a community-based collaborative knowledge system, wherein a "displayed window indicates the first subscription type is browsing by a web browser for the first virtual community, and indicates a second subscription type is using an email client for the second virtual community, the second subscription type allowing a user to post a reply to the second virtual community by replying to a delivered email message containing a new posting" (emphasis added).

Sakamaki discloses an "information releasing system" comprising terminals 1a-1n, a server 2, and a network 3 (*Sakamaki*, ¶¶ 18-19). *Sakamaki*'s system allows "newly registered information" to be disclosed to users via email (*Sakamaki*, ¶ 32). *Sakamaki* discloses the information by either "mail format" or "Web format" when there is a new comment posted to a forum (*Sakamaki*, ¶ 75). When using the "mail format," a user receives an email containing the contents of the posted comment, and when using

the “Web format,” the user simply receives a notification that a comment has been posted (*Sakamaki*, ¶ 75).

However, *Sakamaki* does not teach or suggest allowing a user to post to a forum by replying to an email. Instead, *Sakamaki* discloses using a forum list, selecting a forum name, and selecting a “post” icon (*Sakamaki*, ¶ 81). Therefore, *Sakamaki* does not teach or suggest “a displayed window indicating … a second subscription type is using an email client for [a] second virtual community, the second subscription type allowing a user to post a reply to the second virtual community by replying to a delivered email message containing a new posting” (emphasis added) as recited by independent claim 1.

Bunney fails to cure the deficiencies of *Sakamaki*. *Bunney* discloses a server computer adapted to transmit a document to a client computer (*Bunney*, abstract). *Bunney* also discloses selecting an icon 43 to add links to a user’s personal menu (*Bunney*, ¶ 61), and allowing a user to edit the menu (*Bunney*, ¶ 63). However, *Bunney*’s personal menu does not allow a user to set a subscription type so that the user can respond to forums or virtual communities by replying to an email. Therefore, *Bunney* does not teach or suggest “a displayed window indicating … a second subscription type is using an email client for [a] second virtual community, the second subscription type allowing a user to post a reply to the second virtual community by replying to a delivered email message containing a new posting” (emphasis added) as recited by independent claim 1.

In view of the above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, the Office Action has failed to clearly articulate a reason why independent claim 1 would have been obvious to one of ordinary skill in view of the art. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of independent claim 1 under 35 U.S.C. § 103(a).

Independent claims 9 and 17, although of different scope from claim 1 and from each other, recite elements similar to those discussed above with respect to claim 1. Accordingly, for at least the reasons discussed above with respect to claim 1, no *prima facie* case of obviousness has been established for claims 9 and 17. Therefore, the Examiner should withdraw the rejection of claims 9 and 17 under 35 U.S.C. § 103(a).

Claim 4 depends from claim 1 and claim 12 depends from claim 9 and therefore include all the elements recited therein. Accordingly, no *prima facie* case has been established with respect to claims 4 and 9 at least due to their dependence. Therefore, Applicants respectfully request the Examiner to withdraw the rejection of claims 4 and 12 under 35 U.S.C. § 103(a).

III. The Rejection of Claims 2, 3, 10, 11, and 18 under 35 U.S.C. § 103(a)

Independent claims 2, 10, and 18, although of different scope from claim 1 and from each other, recite elements similar to those discussed above with respect to claim 1. As discussed, *Sakamaki* does not teach or suggest “a displayed window indicating ... a second subscription type is using an email client for [a] second virtual community, the

second subscription type allowing a user to post a reply to the second virtual community by replying to a delivered email message containing a new posting" (emphasis added) as recited by independent claim 1.

Guheen fails to cure the deficiencies of *Sakamaki*. *Guheen* discloses utilizing various types of user indicia to customize a user interface (*Guheen*, abstract). *Guheen* also discloses allowing “participation” in discussions such as newsgroups or forums “via email” (*Guheen*, col. 207, lines 40-49). However, *Guheen* does not teach or suggest that participating is done by replying to a delivered email message that contains a new posting to the newsgroup or forum. Therefore, *Guheen* does not teach or suggest “a displayed window indicating ... a second subscription type is using an email client for [a] second virtual community, the second subscription type allowing a user to post a reply to the second virtual community by replying to a delivered email message containing a new posting" (emphasis added) as recited by independent claim 1.

In view of the above, the final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, the final Office Action has failed to clearly articulate a reason why independent claims 2, 10, and 18 would have been obvious to one of ordinary skill in view of the art. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of independent claims 2, 10, and 18 under 35 U.S.C. § 103(a).

Claim 3 depends from claim 2 and claim 11 depends from claim 10 and therefore include all the elements recited therein. Accordingly, no *prima facie* case has been

established with respect to claims 3 and 11 at least due to their dependence.

Therefore, Applicants respectfully request the Examiner to withdraw the rejection of claims 3 and 11 under 35 U.S.C. § 103(a).

IV. The Rejection of Claims 6, 8, 14, 16, and 19 under 35 U.S.C. § 103(a)

Independent claims 6, 14, and 19, although of different scope from claim 1 and from each other, recite elements similar to those discussed above with respect to claim 1. As discussed, *Sakamaki* and *Bunney* do not teach or suggest “a displayed window indicating ... a second subscription type is using an email client for [a] second virtual community, the second subscription type allowing a user to post a reply to the second virtual community by replying to a delivered email message containing a new posting” (emphasis added) as recited by independent claim 1.

Smith fails to cure the deficiencies of *Sakamaki* and *Bunney*. *Smith* discloses a visualization system that provides improved visualizations of relationships and connections in collaborative information such as email, chats, and bulletin boards (*Smith*, abstract). *Smith* also discloses that the system can be used with Usenet posts, and that many posts reference or reply to other posts (*Smith*, col. 5, lines 35-57). However, *Smith*’s system does not include a subscription type so that the user can respond to forums or virtual communities by replying to an email. Therefore, *Smith* does not teach or suggest “a displayed window indicating ... a second subscription type is using an email client for [a] second virtual community, the second subscription type allowing a user to post a reply to the second virtual community by replying to a delivered

email message containing a new posting" (emphasis added) as recited by independent claim 1.

In view of the above, the final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, the final Office Action has failed to clearly articulate a reason why independent claims 6, 14, and 19 would have been obvious to one of ordinary skill in view of the art. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of independent claims 6, 14, and 19 under 35 U.S.C. § 103(a).

Claim 8 depends from claim 6 and claim 16 depends from claim 14 and therefore include all the elements recited therein. Accordingly, no *prima facie* case has been established with respect to claims 8 and 16 at least due to their dependence. Therefore, Applicants respectfully request the Examiner to withdraw the rejection of claims 8 and 16 under 35 U.S.C. § 103(a).

V. The Rejection of Claims 7, 15, and 20 under 35 U.S.C. § 103(a)

Independent claims 7, 15, and 20, although of different scope from claim 1 and from each other, recite elements similar to those discussed above with respect to claim 1. As discussed, *Sakamaki* and *Bunney* do not teach or suggest "a displayed window indicating ... a second subscription type is using an email client for [a] second virtual community, the second subscription type allowing a user to post a reply to the second virtual community by replying to a delivered email message containing a new posting" (emphasis added) as recited by independent claim 1.

Knight discloses an “online electronic message board system” including a network server connected to a user computer system (*Knight*, col. 8, line 15 to col. 9, line 4). However, in *Knight*, the only way a subscriber can use the online message board is via a web browser (*Knight*, Figs. 3B, 3C; col. 11, lines 21-31). Therefore, *Knight* does not teach or suggest “a displayed window indicating ... a second subscription type is using an email client for [a] second virtual community, the second subscription type allowing a user to post a reply to the second virtual community by replying to a delivered email message containing a new posting” (emphasis added) as recited by independent claim 1.

In view of the above, the final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, the final Office Action has failed to clearly articulate a reason why independent claims 7, 15, and 20 would have been obvious to one of ordinary skill in view of the art. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of independent claims 7, 15, and 20 under 35 U.S.C. § 103(a).

VI. Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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